

REQUEST FOR RECONSIDERATION
U.S. Patent Application No. 10/020,956

surface of the hub, as said magnetic tape is being wrapped around said hub (when the magnetic tape wrapping force in a radial direction is so great that both the hub 11 and the inner rib 12 are deformed which would inherently deflect both flanges), by deflecting the upper and lower flanges toward each other over an entire circumference thereof, as allegedly shown in FIGs. 1 and 2. Moreover, in the section entitled "Response to Arguments," the Examiner alleges that Iwahashi shows the same structural elements except that it was designed to prevent the outer cylindrical section from radially bending inward. However, the Examiner alleges that when the magnetic tape wrapping force in a radial direction is greater than the hub and the inner rib structures, then it would inherently deform both the hub and the inner hub, thus causing both flanges to deflect as the tape is wound around the hub.

For the following reasons, Applicant respectfully disagrees with the Examiner's position and analysis. First, claim 1 recites, *inter alia*, "means for gradually decreasing a distance between said upper flange and said lower flange outside an outer peripheral surface of the hub, as said magnetic tape is being wrapped around said hub, by deflecting said upper and lower flanges towards each other over an entire circumference thereof." Clearly, unless an element performs identically to a function as it is specified in the claim, it cannot be an equivalent for the purposes of 35 U.S.C. § 112, sixth paragraph. MPEP § 2184 (citing *Penwalt Corp. v. Durand-Wayland, Inc.*, 833 F.2d 931, 4 USPQ2d 1737 (Fed. Cir. 1987)). Here, there is nothing whatsoever in Iwahashi, nor has the Examiner shown any teaching or suggestion, that Iwahashi's structure performs the above-noted exact function as set forth in Applicant's claim 1.

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While Iwahashi discloses a tape reel in FIGs. 1 and 2 which appears to have a somewhat similar structure to that of the subject tape reel, Iwahashi specifically discloses that the ribs 21, which extend between the outer and inner cylindrical sections 11 and 12, "may successfully prevent the inner (sic) cylindrical section 11 from bending radially inward so as not to cause stress in a tape wound around the tape reel section." (See column 5, lines 30-34). Further, in column 5, lines 53-56, Iwahashi discloses that "the ribs 21 also prevent the outer cylindrical section 11 from radially and inwardly bending by the pressure exerted from the tape wound therearound." Thus, not only is there no disclosure of the exact function set forth in Applicant's claim 1, but the reference actually specifically teaches that it does not perform that function, i.e., it prevents the subject function of the present invention.

The Examiner apparently takes the position that, because of the structure disclosed in Iwahashi, when the magnetic tape wrapping force in a radial direction is greater than the hub and the inner rib structures, then it would inherently deform both the hub and the inner hub, thus causing both flanges to deflect as the tape is wound around the hub. However, to establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by a person of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. (See MPEP 2112).

In the present case, the Examiner appears to set forth a hypothetical situation where the magnetic tape wrapping force in a radial direction is "greater than the hub and the inner rib

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structures” so that the magnetic tape wrapping force would inherently deform both the hub and the inner hub. However, as noted above, Iwahashi expressly discloses that the ribs 21 prevent the outer cylindrical section from radially and inwardly bending by the pressure exerted from the tape wound therearound, so that this hypothetical situation described by the Examiner would never happen in Iwahashi. Moreover, it is pointed out to the Examiner that a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. MPEP 2141.02 (citing *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)).

Based on the foregoing, it seems clear that the Examiner is mischaracterizing the teachings of Iwahashi as they appear to be directly contradictory to the principle of the subject tape reel wherein the movement of the upper flange and the lower flange is brought about when the cylindrical portion of the hub is deformed in a radial direction (as shown by the broken lines) by winding the tape, so that an inner rib is also deformed (see page 3 of the Rule 132 Declaration and the corresponding figure therein).

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

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Respectfully submitted,



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